Kinser, Robin D.

From: Carchman, Loreen
Sent: Thursday, December 06, 2001 10:12 AM
To: Kinser, Robin D.; Roethig, Hans
Cc: Oey, Jan; Tricker, Anthony; Rustemeier, Klaus
Subject: RE: methods developed by MDS

Robin,

I am not sure what MDS Statements you are referring to. According to the Master Agreement which they have agreed to, but not yet signed, the following is Article 12 which relates to Intellectual Property Rights:

ARTICLE 12 - INTELLECTUAL PROPERTY RIGHTS

12.01 Contractor acknowledges and agrees that any equipment, software, documents or other materials provided to it by Company shall be and remain the exclusive property of Company. Nothing contained herein is intended or shall be deemed to transfer to Contractor any ownership or other rights in or to such equipment, software, documents or other materials. Contractor shall not attempt to decompile, reverse engineer, disassemble or otherwise alter such equipment, software, documents or other materials, and shall promptly return them to Company following completion of the applicable Project.

12.02 Any new or improved apparatus, process, formula, information, invention, idea, suggestion or product discovered, produced, reduced to practice or presented by Contractor or its Personnel in, or as a result of, the performance of Services (or as a result of any other work performed by Contractor for Company) or as a result of any information provided to Contractor by Company or its representatives (collectively "Inventions") shall belong to Company, and Contractor shall promptly communicate full information regarding the same to Company.

12.03 All Work Products (including Inventions) that are works of authorship shall be deemed "works made for hire" within the meaning of the copyright laws of the United States and the equivalent in any similar laws of other jurisdictions, and Company shall own all right, title and interest in and to such Work Products. Contractor acknowledges and agrees that Company may use all Work Products for any purposes that Company deems appropriate, including without limitation publication of such Work Products or submission of such Work Products to governmental or regulatory authorities, and Contractor agrees that Contractor and its Personnel shall not claim that any Work Product is Confidential Information of Contractor or that Contractor or its Personnel otherwise have rights in or to such Work Product. Contractor shall cause its Personnel to comply with the requirements of this Section 12.03.

12.04 To the extent, if any, that Contractor or its Personnel have rights in Inventions or Work Products notwithstanding the provisions of Sections 12.02 and 12.03, Contractor hereby irrevocably assigns to Company all right, title and interest in and to such Inventions and Work Products, including without limitation all patent, copyright, trademark, trade secret and other proprietary rights therein that may be secured in any place under laws now or hereafter in effect. Upon the request of Company, Contractor shall, and shall cause its Personnel to, sign and deliver any assignments or other documents and otherwise assist Company to obtain, maintain, perfect or enforce any of Company's rights hereunder including, without limitation, executing through attorneys-in-fact named by Company any United States or foreign patent application or applications and making such assignments thereof to Company as may be necessary for Company to obtain a patent or patents.

Source: https://www.industrydocuments.ucsf.edu/docs/jzfk0001

12.05 Notwithstanding Sections 12.02 through 12.04, if a Project Agreement expressly provides that Company will not own certain specifically identified Inventions or Work Product, then Company's rights in and to such specifically identified Inventions and Work Product shall be as specified in the Project Agreement. If Company's rights are not specified in the Project Agreement, then Contractor hereby grants to Company a worldwide, non-exclusive, fully-paid up, perpetual license to use, reproduce, make derivative works based upon, distribute, and publicly display and perform such Work Product and to make, use, offer to sell or sell, and import Inventions. Company may exercise such rights through third parties who agree to use such Work Product and Inventions on Company's behalf.

12.06 Contractor shall have valid and enforceable written agreements with all of its Personnel providing Services containing a non-disclosure obligation comparable in scope to that set forth in Article 11 and giving Contractor all rights and authority necessary to effectuate the provisions of this Article 12. Contractor shall provide copies of such agreements to Company upon Company's request.

What this says to me, if MDS does work for hire, it is the property of the Company's, I would consider methods under this topic.

If perhaps, it is not included in 12.03, then it should be included in 12.04 where we have an irrevocable license to use.

Hopefully this takes care of your concerns. If there are any more questions, or I did not fully address your question, please let me know.

Thanks,
-L

-----Original Message-----
From: Kinser, Robin D.
Sent: Wednesday, December 05, 2001 6:48 PM
To: Roethig, Hans
Cc: Kinser, Robin D.; Oey, Jan; Carchman, Loreen; Tricker, Anthony; Rustemeier, Klaus
Subject: methods developed by MDS

Dear Hans--

You will recall that I have expressed concern to you about MDS statements indicating that the methods they develop for our study will be proprietary to them. Several of the PM analysts who have seen this work product have commented on the same statement. What I have recommended to you previously, and what seems to be a consensus opinion of my colleagues, is that Philip Morris should have the right to have the methods MDS develops for us utilized by anyone we would choose in order to address Philip Morris questions, without an additional payment to MDS. We also want to have this work published, and want the analytical details included in any publication. Let me know if I can provide further assistance in resolving this issue.

--Robin

Robin Kinser
804-274-5905
Robin.D.Kinser@pmusa.com

Source: https://www.industrydocuments.ucsf.edu/docs/jzfk0001